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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte A. CARLETON ELLIOTT, ALLAN J. SWARTZ  
and GREGORY KULPA*

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Appeal 2009-012363  
Application 10/773,757  
Technology Center 3600

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Before JOHN C. KERINS, KEN B. BARRETT and MICHAEL C.  
ASTORINO, *Administrative Patent Judges.*

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

A. Carleton Elliott et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-3 and 8. Claims 9-17 have been canceled, and claims 4-7 have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We AFFIRM.

## THE INVENTION

Appellants' claimed invention is directed to a compression post. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A compression post for a shear wall positioned on a structural support, the compression post comprising:

a plate having a first surface mountable to a bottom surface of an end post of a shear wall, the first surface of the plate having dimensions selected to conform to the bottom surface of the end post, the plate having a second surface generally parallel to the first surface; and

an extended portion positioned generally perpendicular to the second surface of the plate, the extended portion having at least one dimension selected to fit through a hole in a mudsill of the shear wall, the extended portion having an exposed end displaced from the second surface of the plate by a length selected to conform to a thickness of the mudsill such that when the compression post is mounted to the end post of the shear wall and the shear wall is mounted on a structural support, the exposed end of the extended portion rests on the structural support and forces applied to the compression post by the end post are

communicated via the plate and the extended portion to the structural support.

## THE REJECTIONS

The Examiner has rejected:

- (i) claims 1, 2, and 8 under 35 U.S.C. § 102(b) as being anticipated by Weber (US 6,015,139, issued January 18, 2000); and
- (ii) claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Weber.

## ISSUES

Did the Examiner err in finding that Weber discloses the invention set forth in claim 1?

Did the Examiner err in concluding that the subject matter of claim 3 would have been obvious in view of Weber?

## ANALYSIS

### *Claims 1, 2 and 8--Anticipation--Weber*

Appellants urge that the compression post set forth in claim 1 is not anticipated by the Weber device. Appellants first argue that the claimed compression post is defined in the preamble in the context of being used with a shear wall positioned on a structural support. (Appeal Br. 7).

Appellants acknowledge that the Examiner's position in this regard is that the Weber device is capable of being used in the same manner, but assert that the Examiner provides no support for this contention. (Appeal Br. 8).

However, it is clear that the Examiner is relying on the structural identity of the Weber device to the structural elements that are positively recited in the claims as the basis for this position. (*See*, Answer 5). As the Weber device

does have a plate and an extended portion configured in the same manner as in claim 1, the Examiner was justified in taking the position that the Weber device is inherently capable of being used in a construction of a shear wall positioned on a structural support, with the burden shifting to Appellants to establish that the Weber device is not capable of such use. *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997). Similarly, the structural identity to the claimed invention provides a basis for regarding the Weber device as a compression post. Appellants have not carried the burden of showing that the Weber device is not capable of use as a compression post used in the construction of a shear wall positioned on a structural support.

Appellants further argue that the Weber plate does not have a first surface mountable to a bottom surface of an end post of a shear wall, in that surface 20 of the Weber plate has locking members extending downwardly from the surface, which would preclude the surface from being mountable to the bottom surface of an end post of a shear wall, which, according to Appellants, would not have any feature to engage the locking members. (Appeal Br. 8-9). Not only is there no end post positively recited in claim 1 such that it could be determined whether the end post has or does not have an engagement feature, the Weber locking members are not integral components of the Weber plate, and thus the plate without the locking members present would not require an end post to have any special engagement feature. We do not find error in the Examiner's position that the Weber plate has a surface mountable to a bottom surface of an end post, as claimed.

The remaining arguments advanced by Appellants are directed to allegations that the Weber device does not disclose the dimensions of several

components of Appellants' claimed device. (Appeal Br. 9-12). In particular, Appellants contend that Weber does not disclose that: (1) the first surface of the plate in Weber does not have dimensions selected to conform to a bottom surface of an end post; (2) the upstanding sleeve of Weber does not have at least one dimension selected to fit through a hole in a mudsill of a shear wall; and (3) the upstanding sleeve of Weber does not have a length that conforms to a thickness of a mudsill. (*Id.*).

The Examiner correctly points out, and Appellants acknowledge, that none of a shear wall, an end post, and a mudsill is positively recited in claim 1. (Ans. 5; Appeal Br. 11). While Appellants argue on the one hand that the dimensions are claimed in that manner because persons skilled in the art would be familiar with such dimensions, Appellants also note that, “[a]s described in the specification, if the end post or the mudsill has different dimensions, the dimensions of the plate and the length of the extended portion are selected to conform to the dimensions.” (Appeal Br. 12).

Accordingly, the Weber device has a plate surface that will conform with a bottom surface of an end post having similar dimensions to it, and has an upstanding sleeve that will fit through an appropriately sized hole in a mudsill, and the upstanding sleeve will have a length that conforms to a similarly dimensioned thickness of a mudsill. Nothing in claim 1 limits the end post and mudsill to having any specific dimensions, as Appellants tacitly admit in the passage quoted above.

Appellants arguments to the effect that the Examiner has failed to make out a *prima facie* case of obviousness with respect to claim 1 are of no consequence here, where the rejection is one based on anticipation, not obviousness.

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We thus do not find error in the Examiner's ultimate finding that claim 1 is anticipated by Weber. Appellants rely on the same arguments as were advanced for claim 1 in arguing the patentability of claims 2 and 8, as such, those claims fall with claim 1.

*Claim 3--Obviousness--Weber*

Appellants expressly rely on the same arguments for patentability as were advanced for claim 1 (Appeal Br. 19), which arguments are, as discussed above, not persuasive of patentability. Accordingly, the rejection of claim 3 as being unpatentable over Weber will be sustained.

#### CONCLUSIONS

The Examiner did not err in finding that Weber anticipates the invention set forth in claims 1, 2 and 8.

The Examiner did not err in concluding that the subject matter of claim 3 would have been obvious in view of Weber.

#### DECISION

The decision of the Examiner to reject claims 1-3 and 8 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG